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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,571	06/09/2000	BERNARD CALAS	19904-009	2070

7590 06/06/2005
BACHMAN & LAPOINTE P.C.
900 CHAPEL STREET SUITE 1201
NEW HAVEN, CT 06510-2802

EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/485,571	Applicant(s) CALAS ET AL.	
	Examiner Chih-Min Kam	Art Unit 1653	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 18 March 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: 18, 20 and 37.

Claim(s) rejected: 18-20, 24, 29, 30, 32-34, 37 and 38.

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☒ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____

Handwritten signature/initials

Continuation of 3. NOTE: The amendment to the claims does not resolve the current issues under 35 USC 112, first paragraph, it also raise issues regarding new matter indicating a compound of formula (IV) is (A)-Zm. In the amendment of March 18, 2005, claims 18, 20, 24, 29, 30, 33, 37 and 38 have been amended; and claim 32 has been cancelled. Applicants' response has been fully considered, however, claims 18-20, 24, 29, 30, 33-34, 37 and 38 are rejected under 35 USC 112, first paragraph.

If applicants' amendment were entered, it would have the following response:

1. Claims 18-20, 24, 29, 30, 33-34, 37 and 38 are rejected under 35 USC 112, first paragraph, because the specification, while being enabling for a linear peptide of SEQ ID NO:23; a specific compound of formula (IV), wherein A is the amino acid sequence of SEQ ID NO:23, Z is an active substance, $m=1$ and $n=0$; or a method of vectoring an active substance to a target cell using the conjugate of active substance-linear peptide, wherein the linear peptide is the amino acid sequence of SEQ ID NO:23, does not reasonably provide enablement for a linear peptide comprising the sequence of SEQ ID NO:23 to vectorize active substances; a compound of formula (IV), (A)-Zm, wherein A is a linear peptide comprising SEQ ID NO:23; a pharmaceutical composition a diagnostic agent comprising the compound of formula (IV); or a method of vectoring an active substance to a target cell, cell compartment, or organ using a conjugate of active substance and a linear peptide comprising SEQ ID NO:23. The specification does not enable a person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims (see paragraph 8 of the Office Action dated 12/16/04). The specification shows the internalization ability of the amino acid sequence of SEQ ID NO:23 in certain cell lines, however, it does not provide sufficient teachings on the effects of linear peptides comprising SEQ ID NO:23 in vectoring various active substances to target cells or organs.

In response, applicants indicate claims 18, 20 and 37 have been amended to delete the language relating to the moiety of the linear peptide of SEQ ID NO:23, and a technical report submitted by the applicants provides additional working examples for vectorizing an active substance (e.g., a polypeptide, an antibody, a nucleic acid, an oligonucleotide or a chemical molecule), thus there is no undue experimentation to arrive the claimed linear peptide, composition and method.

The response has been considered, the argument is persuasive regarding the active substance, which is enabled (see above). However, the specification only demonstrates the effect of the sequence of SEQ ID NO:23, it does not provide sufficient teachings regarding all linear peptides comprising SEQ ID NO:23 in vectoring various active substances to target cells or organs.

2. Claims 29, 30, 33, 34, 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The specification discloses a compound of formula (IV) is (Y)n-(A)-(Z)m (page 12, line 17), it does not indicate formula (IV) is (A)-Zm, although (A)-Zm is a specific compound of formula (IV) when $n=0$.

3. Claims 20 and 37 are objected to because of the use of "SEQ. ID NO.: 23". Use of "SEQ ID NO:23" is suggested.

Continuation of 5. Applicant's reply has overcome the following rejection(s): If entered, the rejection of claims 20, 30, 33 and 38 under 35 USC 112, second paragraph.

Continuation of 11. does NOT place the application in condition for allowance because: The amendment to the claims does not resolve current issues under 35 USC 112, first paragraph.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8:00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Patent Examiner

CMK

CMK
June 1, 2005


JON WEBER
SUPERVISORY PATENT EXAMINER